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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	[illegible]

HM22/0710

MICHAEL L GOLDMAN
NIXON HARGRAVE DEVANS AND DOYLE
CLINTON SQUARE
P O BOX 1051
ROCHESTER NY 14603

EXAMINER
[illegible]

ART UNIT	PAPER NUMBER
[illegible]	38

DATE MAILED: 07/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/794,851	Barany et al
Examiner	**Art Unit**
P. Ponnaluri	1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 2, 2001*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-43, ~~45-66, 75-80~~, 82-88, and 138-151* is/are pending in the application.

45-80

4a) Of the above, claim(s) 67-74 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-43, 45-66, 75-80, 82-88, and 138-151* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☒ Interview Summary (PTO-413) Paper No(s). 37

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and also the finality of action is withdrawn in this case, in view of the newly discovered related US patent and US pending applications.

2. Claims 1-43, 45-66, 75-80, 82-88 and 138-151 are currently pending in this application.

3. The amendments filed on 4/12/01 have been fully considered and entered into the application.

4. The declaration of Francis Baran, under 37 CFR 1.132 filed on 1/30/01 is sufficient to overcome the rejection of claims 1-43, 45-66, 75-80, 82-88 and 138-151 based upon the art rejections.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-43, 45-66, 75-80, 82-88, 138-151 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,027,889. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the instant claimed method recites similar steps, the method of identifying one or more of a plurality of sequences as the reference method. The reference method differs from the instant method by reciting steps for formation of polymerase chain reaction mixture. The ~~reference~~ instant method does not differ from the ~~reference~~ method and it would be obvious that the reference method steps can be used along with the instant method steps, and the use of the solid support would not make the instant claims different from the reference method.

7. Claims 1-43, 45-66, 75-80, 82-88, 138-151 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-54 of copending Application No. 09/440,523. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method of identifying one or more of a plurality of sequences in an array would be encompassed by the reference method. The reference includes PCR step, which was not present in the instant method. However, the instant claims recite comprising, which is open to additional method steps..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Applicant's arguments filed on 4/2/01, regarding the potential obviousness double patenting rejections set forth in the advisory action, have been fully considered but they are not persuasive.

Applicants argue that the present application has a different inventive entity from that of the US patent applications Serial No. 09/440,523, and US Patent 6,027,889. Applicants

arguments have been fully considered but are not persuasive, because one of the inventor (Francis Barany) is same in all the applications. Thus, these applications have same inventive entity.

*Applicants argue that obviousness-type double patent rejection can not be made where the claimed invention of a first patent would not have been obvious variant of the claimed invention of a second patent application. Applicants arguments are not persuasive, because the instant claimed method steps are open to other method steps of the reference (or the `851 application and the `889 patent) additional PCR step. Thus, it would be obvious to include a PCR step to obtain multiple primers in the instant claimed method. Applicants also argue that to determine claims to a basic invention in a first filed application would have been an obvious variant of the claims directed to an improvement in an application which was filed after the first filed application but which issued first, a two-way patentability evaluation must be satisfied. Applicants arguments are not persuasive, because 'even if the application at issue is the earlier filed application, only a one-way determination of obviousness is needed to support a double patenting rejection in the absence of a finding of: (A) administrative delay on the part of the Office causing delay in prosecution of the earlier filed application; **and** (B) applicant could not have filed the conflicting claims in a single application.' See MPEP 804. A two-way test is applied only when the applicant could not have filed the claims in a single application and there is administrative delay. In the absence of the administrative delay, a one-way test is appropriate.*

9. No claims are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday to Thursday from 6.30 AM to 4.00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venakt, Ph.D., can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

P. Ponnaluri
Technology Center 1600
28 June 2001

PADMASHRI PONNALURI
PRIMARY EXAMINER